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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,106	02/16/2001	Martin Sugar	BEIERSDORF 7	3482

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EXAMINER	
WANG, SHENGJUN	

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/763,106	SUGAR ET AL.	
	Examiner	Art Unit	
	Shengjun Wang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *7,12-17 and 19-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7,12-17 and 19-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted April 18, 2005 is acknowledged.

Claim Rejections 35 U.S.C. 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 31-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims have negative limitation for sulfosuccinic acid monoesters. The application, as originally filed, lacks support for such limitation. The application never mentions sulfosuccinic acid monoesters.

Claim Rejections 35 U.S.C. 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 7, 12-17, 19-24, and 28-3-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Mager et al. (JP 09-301834).

3. Mager et al. exemplify a hair washing agent comprising 1-14% N-acylglutamate and 1-

14% sodium lauryl ether sulfate that is applied to the hair. See abstract. The R2 in acyl group is alkyl of C10 to C18. and cocoyl glutamate is the preferred acylglutamate. See, particularly the claims and paragraph 20. As to the particular cation, sodium, of the acyglutamate herein recited in claims 28-30, note sodium was used in the hair washing composition, including sodium hydroxide, and sodium salt of lauryl ether sulfate. See, e.g., the examples. Therefore, the sodium salt of acylglutamate would be present once al the ingredients are mixed. It is respectfully pointed out that application of a shampoo to hair also results in application of the composition to the scalp. The claims are directed to a method of applying a composition comprising lauryl ether sulfate and more than 3% N-acylamino acids and/or salts to the skin. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 199%. See MPEP 2 1 12.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches application to the skin of compositions containing the same components as instantly claimed, which would inherently reduce the attachment of a lauryl ether sulfate or desorb a lauryl ether sulfate from human skin, as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed. As to the new claims 19-24 which recite the step of applying to human body, note scalp is part of human body. Further, washing hair and scalp in a shower bath, shampoo would be inevitably applied to the whole body.

Claim Rejections 35 U.S.C. 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 7, 12-17, 19-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamato et al. (4,749,515)

6. Miyamato et al. teaches a detergent composition having good rinsing off properties and imparting smoothness to hair and skin. The composition comprises about 0.1-20% of N-acylated compounds, wherein the preferred acylated compounds include N-lauroylglutamic acid, N-myristoylglutamic acid, N-acyl peptides, and other N-acyl amino acids herein recited, or their alkali metal salts. Lauryl ether sulfate is one of exemplified detergent agent used in the composition. See, particularly, the abstract, col. 1, lines 51-63, tables 1 and 2 in columns 4-8 and the claims.

7. Miyamato et al. does not teach expressly using a detergent composition comprising lauryl ether sulfate, as detergent agent, and more than 3% of N-acylamino acid for bath or shampoo.

8. However, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to use a detergent composition comprising lauryl ether sulfate, as detergent agent, and more than 3% of N-acylamino acid for bath or shampoo because the addition of N-acyl amino acid would improve the rinsing properties (i.e., reducing or

preventing the attachment of the detergent from the skin), and impart smoothness of the skin. As to the particular amount of N-acyl amino acid, note in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

Response to the Arguments

Applicants' amendments and remarks submitted April 18, 2005 have been fully considered, but are not persuasive.

Applicants argue that the claims are not anticipated by Mager et al. because Mager teach N-acylamino acid is merely a optional and there is no specific example containing both lauryl ether sulfate and N-acyl amino acid. Applicants' arguments are not convincing. What Mager et al. taught is a genus consisting of nine species and the claimed subject matter is one of them. The examiner has recognized that a genus does not always anticipate a claim to a species within the genus. However, when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named. Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) (The claimed compound was named in a reference which also disclosed 45 other compounds. The Board held that the comprehensiveness of the listing did not negate the fact that the compound claimed was specifically taught. The Board compared the facts to the situation in which the compound was found in the Merck Index, saying that "the tenth edition of the Merck Index lists ten thousand compounds. In our view, each and every one of those compounds is described' as that term is used in 35 U.S.C. § 102(a), in that publication."). Id. at 1718. See also In re Sivaramakrishnan, 673 F.2d 1383, 213 USPQ 441 (CCPA 1982). See, also MPEP 2131.02.

Applicants further argue that the claims are not anticipated because shampooing does not necessarily wetting the scalp or any part of the skin. The arguments are not persuasive. Nowhere in Mager et al. requires the hair washing composition should be kept from contacting skin. The examiner contends that a common shampooing process for a normal person would inevitably resulting the contact of the shampoo composition with skin.

9. Applicants contend that there is nothing in the Miyamoto that would have led person skilled in the art to the particular combination herein. The arguments are not persuasive. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Miyamoto clearly teaches the motivation to combine, "improve the rinsing properties, and impart smoothness of the skin."

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHENGJUN WANG
PRIMARY EXAMINER

Shengjun Wang
Primary Examiner
Art Unit 1617